

**Remarks**

The Office Action mailed March 6, 2006 has been carefully reviewed and the following remarks are made in consequence thereof.

Claims 1-15 and 19-30 are now pending in this application, of which claims 1-4, 6, 19, 21 and 27 have been amended. Claims 28-30 are newly added. It is respectfully submitted that the pending claims define allowable subject matter.

The objection to the drawings is respectfully traversed.

Applicants note that claim 2 recites that the resistance mechanism “is selected from the group of a coil spring, a rotational dial, an elastic material, a magnetic component, an electrical component, a chemical component reactive to lifting of the bag, and an electromechanical element. The drawings of record clearly illustrate resistance mechanisms “selected from the group” recited in claim 2. Thus, the drawings do illustrate the features of the invention specified in claim 2, and the objection to the drawings is respectfully believed to be misplaced.

Applicants note that claim 3 recites that the piece of luggage comprises one of a backpack, a suitcase, a briefcase, a computer bag, a duffel bag, an upright bag, a garment bag, and a shoulder bag. The drawings of record clearly illustrate pieces of luggage that are one of the bags recited in claim 3. Thus, the drawings do illustrate the features of the invention specified in claim 3, and the objection to the drawings is respectfully believed to be misplaced.

Applicants accordingly request that the objection to the drawings be withdrawn.

The rejection of claims 2, 10, 22, and 25 under 35 U.S.C. § 112, first paragraph, is respectfully traversed.

The Office Action indicates that claims 2, 10, 22, and 25 fail to comply with the enablement requirement. Applicants note that enablement relates to the specification and not to the claims, and will respond under the understanding that the Examiner intended to object to the specification and not to the claims by invoking the first paragraph of Section 112.

Applicants respectfully submit that, as noted at least in paragraphs [0042] and [0045] of the specification, a number of resistance mechanisms may alternatively be used in embodiments of the invention, including but not limited to elastic materials, coil springs, flat springs, magnetic or electric fields, chemical reactions, electromechanical elements, or any other type of system or device which can measure a force. Applicants submit that such mechanisms, types and systems for measuring force are known and would be readily appreciated by those in the art. Having described at least two other embodiments in detail in the specification (a mechanical version and an electronic version), it is believed that implementation of any of the noted alternative force measuring mechanisms or devices in lieu of the mechanical and electronic versions described in detail) is within the purview of those in the art without further explanation or detail. It is believed that the specification is completely enabling for all of the variations of resistance mechanisms referred to in the specification.

With respect to claims 10 and 25, it is not believed that explanation of a reset button works in an electronic device is necessary. Electronic devices having reset features and buttons are well known and it is not believed that an artisan would require specific explanation and teaching regarding implementation of such a feature. (Indeed, elsewhere in the Office Action the reset button is asserted to be obvious in view of the Reder et al. patent.) Also, Applicants have not claimed a reset button for a resistance mechanism having springs as suggested in the Office Action, but nonetheless submit that resetting or re-zeroing of a mechanical force measuring system is simply a matter of calibration and is certainly possible if desired. Applicants again submit that the same would be apparent to one of ordinary skill in the art.

For the reasons set forth above, Applicants respectfully submit that the rejection of claims 2, 10, 22 and 25 be reconsidered and withdrawn.

The rejection of claims 1-15 and 21 under 35 U.S.C. § 112, second paragraph, is respectfully traversed.

Claims 1-4, 6 and 21 have been amended in a manner that is believed to overcome the issues noted in the Office Action. Applicants note that the deletion of “equivalents” in claims 2-4 is in no way intended to surrender a scope of protection afforded to the claims under the

doctrine of equivalents. Applicants disagree with the position taken in the Office Action that “equivalents” are broader than more specific elements (e.g., specific resistance mechanism, types of luggage and types of carrying devices) which the Office Action considers to be narrower. Applicants submit that an equivalent device by definition is neither broader nor narrower than a specifically denoted device. Applicants have amended claims 2-4 only for the sake of expediency in prosecution and do not acquiesce in any way that such amendments are necessary for patentability.

For the reasons set forth above, Applicants respectfully submit that the rejection of claims 1-15 and 21 be reconsidered and withdrawn.

The rejection of Claims 1-9, 11-15 and 23 under 35 U.S.C. § 102(b) as being anticipated by Marks (U.S. Patent No. 2,759,577) is respectfully traversed.

Applicants previously argued that the Marks reference did not properly qualify as prior art vis-à-vis the present application. The present Office Action states Marks is a valid reference on the ground that the parent application provides support only for the embodiments shown in Figures 1-3 while Figure 4 of the parent application shows an embodiment with four springs, concluding that the effective date of the present application is 12/16/03, a date after the publication date of the Marks reference on December 4, 2003.

In response, Applicants respectfully submit that, regardless of the parent application having four figures versus the eight figures of the present application, independent claim 1 is fully supported by the parent application and is entitled to the priority date of the parent application. The common subject matter in the parent application and the present application share the benefit of the filing of the parent application, and claim 1 is clearly directed to common subject matter disclosed in each of the parent application and the present application. Because the parent application was filed December 16, 2002, well before the publication date of the Marks reference in December 2003, the Marks reference does not qualify as prior art under any provision of 35 U.S.C. § 102. Marks cannot be an anticipating reference without first qualifying as prior art under § 102, and the rejection is respectfully submitted to be improper.

Claims 2-9 and 11-15 depend from claim 1 and likewise cannot be anticipated unless claim 1 is anticipated. Moreover, the subject matter of claims 2-9 and 11-15 are encompassed by and further delineate the subject matter recited in claim 1 which is common to both the parent case and the present application.

Likewise, claim 23 depends from claim 19, which is also fully supported by and entitled to the priority date of the parent application. For the reasons set forth above, Marks is not an anticipating reference to claim 19, and claim 23 cannot be anticipated without claim 19 being anticipated.

Applicants accordingly request reconsideration and withdrawal of the rejection of claims 1-9, 11-15 and 23.

The rejection of claims 19-24 and 26 under 35 U.S.C. § 103(a) as being anticipated by White (U.S. Patent No. 2,759,577) in view of Westman (2,937,016) is respectfully traversed.

Claim 19 recites, among other recitations, that weight is distributed across said means for determining solely by lifting said means for lifting. This is distinguishable from the bag of White, which requires a pushbutton (50) to be depressed to release the scale from a locked position, allowing the bag to subsequently be weighed. It is respectfully submitted that, as a consequence of the pushbutton, the White scale is not operable solely by lifting of the handle, but rather requires actuation of the pushbutton prior to lifting of the handle. The pushbutton and locking/unlocking of the White scale, which is clearly a desirable feature as presented in the White disclosure, is submitted to actually teach away from the present invention.

Westman is cited for disclosing a handle with a button that may be unlocked so that the handle takes the weight of the luggage when lifted. Westman, however, is not submitted to cure the deficiencies of White with respect to the present invention. Westman, like White, teaches a locking mechanism that must be unlocked to use the weighing device. Applicants specifically note that in col. 2, lines 64-70, Westman describes that the locking member (29) is positionable in one position normally used when the handle "functions just as a plain handle" and another position "only employed where the weight of the luggage requires to be determined." Like

White, the non-functionality of the weighing device in normal use is an important feature of Westman and is believed to teach away from the present invention. Neither White nor Westman, considered separately or in combination, teach or suggest weight being “distributed across said means for determining solely by lifting said means for lifting” as claim 19 recites. Rather, each of White and Westman require unlocking of a weighing mechanism *and* lifting of a handle to use the weighing mechanism.

Claim 19 is therefore submitted to be patentable over White.

Claims 20-24 and 26 depend from claim 19, and when the recitations of claims 20-24 and 26 are considered in combination with the recitations of claim 19, claims 20-24 and 26 are likewise submitted to be patentable over White in view of Westman

Applicants therefore respectfully request the rejection of claims 19-24 and 26 be withdrawn.

The rejection of claims 10 and 25 under 35 U.S.C. § 103(a) as being unpatentable over the art cited against claims 1 and 19, and further in view of Reder et al. (U.S. Patent No. 4,660,666) is respectfully traversed.

Reder et al. relates to a strain guage scale for weighing fish, and is believed to add nothing to the teaching of the other cited art with respect to the inventions of claims 1 and 19 respectively. Moreover, Reder et al. does not cure the deficiencies of the other cited art with respect to the inventions of claims 1 and 19, respectively. Claims 1 and 19 are therefore submitted to be patentable over the other cited art in view of Reder et al., and when the recitations of claims 10 and 25 are considered in combination with the recitations of claims 1 and 19, respectively, claims 10 and 25 are likewise submitted to be patentable.

Applicants accordingly submit that the rejection of claims 10 and 25 be withdrawn.

The rejection of claims 19-22 and 27 under 35 U.S.C. § 103(a) as being anticipated by Atherton (U.S. Patent No. 2,759,577) in view of Westman (2,937,016) is respectfully traversed.

As explained by Atherton, the embodiment of Figure 7 includes a scale movable from an inoperative position shown in phantom lines to an operable position shown in solid lines. This like White and Westman, is a two step actuation of the scale: first the scale must be moved to the operative position and then the bag must be lifted to weigh the case. This is not weight being “distributed across said means for determining solely by lifting said means for lifting” as claim 19 recites. Also, as described by Atherton, the scale is used by lifting a suspending ring (32) when the scale is in the operative position. In contrast to the present invention, the scale is not operated by lifting of the handle (55).

Claim 19 is therefore submitted to be patentable over Atherton.

Claims 20-22 depend from claim 19, and when the recitations of claim 19 are considered in combination with the recitations of claim 19, claims 20-22 are likewise submitted to be patentable.

With respect to claim 27, claim 27 recites that the lifting element defines a primary means of carrying the container portion, and the weight determining mechanism comprises a resistance element mechanically subjected to a load bearing weight of the container portion whenever the luggage container portion is lifted with the lifting element. In the Atherton case, the scale is inoperable when the handle (55) is in a position (shown in full lines in Figure 7) for carrying of the case with the handle (55). The scale is actuated with a suspension ring when the handle (55) is rotated about a hinge to a weighing position for the scale. Certainly, suspension ring would not be desirable to carry the Atherton case, nor would the handle (55) be used to carry the Atherton case when in the weighing position.

Claim 27 is therefore submitted to be patentable over Atherton.

Applicants according request that the rejection of claims 19-22 and 27 be withdrawn.

With regard to newly added claim 28, the cited art neither discloses nor suggests “an on-board weight determining mechanism permanently connected to the lifting element and subject to a load bearing weight of the container portion when lifted via the lifting element, the weight determining mechanism operable to determine the load bearing weight” and “an indicator


operatively coupled to the weight determining element and selectively operable to indicate information regarding the load bearing weight to a user when the container portion is lifted via the lifting element” as claim 28 recites. As explained above, the cited art discloses locking and unlocking mechanisms, or multiple positions of a handle or scale to engage or disengage a scale or weighing mechanism, and the scales are inoperably in normal use of the handle to carry the bags.

With respect to newly added claim 29, the combination of an “on-board weight determining element permanently connected across opposing ends of the lifting element, the weight determining element responsive to a load bearing weight of the container portion when lifted via the lifting element to determine the load bearing weight” and “a selectively operable indicator operatively coupled to the weight determining element to indicate information regarding the load bearing weight to a user when the container portion is lifted via the lifting element” is not believed to be described or suggested by the cited art. The weighing of the devices of the cited art are engageable and disengageable for use and are not permanently connected across opposing ends of the lifting element as claim 29 recites. Also, indicators of the prior art devices are not selectively operable to indicate information as claim 29 recites.

Claim 30 depends from claim 29, and when the recitations of claim 30 are considered in combination with the recitations of claim 29, claim 30 is likewise submitted to be patentable over the cited art.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Bruce T. Atkins, Reg. No. 43,476  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, MO 63102-2740  
(314) 621-5070